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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

In Re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. C-05-0114JW **ROUND 3 DEFENDANTS' RESPONSE TO ACACIA'S POST-HEARING MEMORANDUM REGARDING '992 PATENT CLAIMS 45 AND 46** Date: Time: Courtroom: Judge: Honorable James Ware

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Introduction

The Round 3 defendants submit this additional memorandum regarding claims 45 and 46 of U.S. Patent No. 5,132,992 ('992 patent), in response to Acacia's Post-Hearing Brief dated August 4, 2006 ("Acacia P-H Br."). For reasons we have previously explained,[1] '992 claims 45 and 46 are indefinite. Nothing in Acacia's post-hearing brief contradicts this inescapable conclusion.

Claim 45 requires "separately storing a plurality of files." But what information is contained in those files, where does it come from, and where does it go? Do these files contain the same "compressed, formatted, and sequenced data blocks" that were created in claim 41? Or do they contain information obtained from some unidentified source and processed in some unidentified way, unrelated to the steps of claim 41?

As set forth below, the "plurality of files" of dependent claim 45 cannot reasonably be construed to be files that have no relationship whatever with the "method of transmitting information to remote locations" of independent claim 41 (the construction advocated by Acacia.) The "plurality of files" must contain information that was retrieved from items in a source material library, coded, formatted, sequenced and compressed in accordance with the steps of claim 41, and at least a portion of which is subsequently sent to one of the remote locations, also in accordance with the steps of claim 41. Even Acacia agrees that the "plurality of files" of claim 45 *may* contain such information.

But if the "plurality of files" must (or even, may) contain the same "compressed, formatted and sequenced data blocks" as are recited in claim 41, two insurmountable problems arise under 35 U.S.C. § 112:

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[1] See Points XXI and XXIII of the Round 3 defendants' May Memorandum, Tabs 8 and 9 of the Round 3 defendants' June Demonstrative Exhibits, and pages 137:4-140:14 of the June 14 *Markman* Hearing transcript.

(1) independent claim 41 *requires* that all of the data be placed in a *single* file, while dependent claim 45 inconsistently requires (or at least permits) that information to be stored in a *plurality* of files; and

(2) claim 45, incorporating claim 41, requires "sending at least a portion of *the file* [singular] to one of the remote locations" – but, if the information is stored in a plurality of files, it is impossible to know *which* file is meant.

Claim 45, and claim 46 on which it depends, are therefore indefinite.

I. The "Plurality of Files" Of Claim 45 Contain The "Compressed, Formatted and Sequenced Data Blocks" That Are Created By The Steps Of Claim 41

Acacia argues that the information in the "plurality of files" in dependent claim 45 need not be the same information that was retrieved and processed by the prior steps of independent claim 41. According to Acacia, the data contained in the "plurality of files" of claim 45 may come from a completely different source. And, according to Acacia, the data contained in the "plurality of files" is *not* the data that is subsequently sent to a remote location as required by claim 41. Rather, according to Acacia, there is a "claim 41 file" which contains information operated upon by the steps of claim 41; and there are "claim 45 files" which do not necessarily have any connection whatsoever with the steps of claim 41, which can be created in any way, which can contain information from any source, and which have nothing to do with the sending of information to remote locations. (Acacia P-H Br. pp. 2-3 and 8.) In other words, according to Acacia, claim 45's step of "storing a plurality of files" is an irrelevant appendage which is tacked on to claim 41's "method of transmitting information to remote locations."

Acacia does not cite any claim language to support its position, and it ignores the claim language which suggests the contrary. Claim 45 incorporates by reference claim 41's self-description as a "method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of [the recited steps]." It is implausible to interpret claim 45 as describing a step that is utterly unrelated and unconnected to the "method of transmitting information to remote locations" of the claim.

Further, claim 45 expressly states that "the step of: separately storing a plurality of files, each including compressed, sequenced data blocks" is performed *as part of* "the storing step" of claim 41, *i.e.*, "storing, as a file, the compressed, formatted, and sequenced data blocks . . ." By its plain language, claim 45 modifies the claim 41 storing step (*i.e.*, it recites "wherein the storing step [of claim 41] further comprises"). Acacia's position that the storing step of claim 45 is a different storing step than the storing step of claim 41 is inconsistent with the plain language of the claim.

In addition, claim 45 requires that the "plurality of files" contain "compressed, sequenced data blocks" – closely tracking the language of the storing step of claim 41, which refers to "compressed, formatted, and sequenced data blocks." The inescapable implication is that the same data blocks are being referred to. Acacia's position that the claim 45 "plurality of files" containing "compressed, sequenced data blocks" need not be created using the steps of claim 41, and indeed need not be created by a transmission system at all, ignores the language of the claim.

II. Claim 45 Is Indefinite

Although Acacia contends that the "plurality of files" of claim 45 need not contain data obtained by the steps of claim 41, even Acacia admits that those files *may* contain such data. (Acacia P-H Br. p. 2-3). As set forth below, claim 45 is indefinite regardless of whether the "plurality of files" *must* contain data obtained by the steps of claim 41, as the Round 3 defendants contend, or whether they *may* contain such data, as Acacia contends.

A. Claim 45 Is An Improper Dependent Claim Because It Modifies, Rather Than Further Limits, Independent Claim 41

Dependent claims are authorized by 35 U.S.C. § 112, ¶ 4, which provides:

> [A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Thus, a dependent claim must "incorporate by reference all the limitations of the claim to which it refers" and then "specify a further limitation of the subject matter."

If a dependent claim *alters* the independent claim rather than *limits* it, it is invalid. *Pfizer Inc. v. Ranbaxy Laboratories Ltd.*, 2006 WL 2137244 (Fed. Cir. 2006). Thus, in *Pfizer*, the dependent claim 6 was to "the hemicalcium salt of claim 2," and claim 2 recited an "acid." The Federal Circuit held that, because an acid is not a salt, dependent claim 6 did not "narrow the scope of claim 2" as required by § 112, ¶ 4 (*Id.* at *5); in fact, it was "completely outside the scope of claim 2." *Id.* at *6. Accordingly, the Court held, the dependent claim was invalid. *Id.*

By the same reasoning, claim 45 cannot survive. Claim 41, by its terms, requires that all of "compressed, formatted, and sequenced data blocks" be stored in a *single* file. But claim 45, which depends on claim 41, requires (or, according to Acacia, permits) the "compressed, formatted, and sequenced data blocks" obtained from the steps of claim 41 to be stored in a *plurality* of files. Thus, claim 45 does not fall completely within the scope of claim 41, incorporating all of its limitations and adding a "further limitation." Instead, claim 45 *alters* the single-file limitation of claim 41 by requiring (or permitting) the compressed, formatted and sequenced data blocks to be stored in multiple files. That is improper.[2]

B. The Claim 41 Step Of "Sending at Least a Portion of *the File*..." Incorporated Into Claim 45 Is Ambiguous

Claim 45 requires that a "plurality of files" be stored. Yet the last step of claim 41, from which claim 45 depends, is "sending at least a portion *of the file* [singular] to one of the remote locations." Which one of the claim 45 "plurality of files" is that?

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[2] Acacia's reliance on *Resonate, Inc. v. Alteon Websystems, Inc.*, 338 F.3d 1360 (Fed. Cir. 2003) is misplaced. (Acacia P-H Br. pp. 3-6.) That case has no applicability here, as it did not involve a dependent claim either altering an independent claim or rendering a limitation of an independent claim indefinite.

Acacia states in conclusory fashion that "it would have been clear to a person of ordinary skill in the art that 'the file' [which is sent in claim 41] refers to the file created in the 'storing, as a file' step." (Acacia P-H Br. p. 8.) There is nothing in the claim language, however, which would direct one of ordinary skill in the art to that conclusion. Even under Acacia's construction of claim 45, by the time the claim 41 step of "sending at least a portion of the file..." step is reached, a plurality of files have been created and stored. The step of "sending at least a portion of *the file*..." provides no hint as to which of these files is sent. Claim 45 is therefore indefinite.

III. Claim 46 Is Indefinite

Acacia argues that even if claim 45 is indefinite, claim 46 is definite because the steps added by claim 46 specify "that the file being sent would be the file having the data blocks that correspond to the user request." (Acacia P-H Br. p. 9.) Claim 46 says no such thing. Claim 46 says:

> 46. A transmission method as recited in claim 45, further comprising the steps, performed by the transmission system, of:
>
> generating a listing of available items;
>
> receiving transmission requests to transmit available items; and
>
> retrieving stored formatted data blocks corresponding to requests from users.

As an initial matter, Acacia assumes, without citing any support, that the steps of claim 46 occur only after the claim 41 storing step. Acacia is wrong. The claims themselves suggest that the steps of claim 46 instead occur after the claim 41 step of "placing the retrieved information into a predetermined format as formatted data." This is because claim 46 refers to "formatted data blocks," but does not say that the data blocks are "compressed" – which suggests that the steps of claim 46 take place after the formatting step but before the compressing step.

Be that as it may, the additional limitations of claim 46 are of no help whatever in curing the defects of claim 45 on which it depends. Claim 46, because it depends from claim 45, still improperly modifies the limitation of claim 41 that the compressed, sequenced data blocks be stored in a *single* file and still provides no information as to *which* file (out of the plurality of files that contain compressed, sequenced data blocks) should be used for transmission of information to a remote location. Even under Acacia's incorrect assumption that the steps of claim 46 occur only after the claim 41 storing step, claim 46 still provides no correlation between the "stored formatted data blocks" it says are retrieved and the "plurality of files" which are stored pursuant to claim 45. Are the data blocks retrieved in claim 46 a portion of one file, are they from a plurality of files, or did they not come from one of the stored files at all? There is still no way to tell which of the "plurality of files" is "*the* file" that is sent.

Thus, claims 45 and 46 are both indefinite.

Respectfully submitted,

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